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| APPLICATION NO.         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/827,485              | 04/06/2001  | Thomas Brumm         | 112740-209          | 5739             |
| 29177                   | 7590        | 06/01/2005           | EXAMINER            |                  |
| BELL, BOYD & LLOYD, LLC |             |                      | RYMAN, DANIEL J     |                  |
| P. O. BOX 1135          |             |                      |                     |                  |
| CHICAGO, IL 60690-1135  |             |                      | ART UNIT            | PAPER NUMBER     |
|                         |             |                      | 2665                |                  |

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/827,485

Applicant(s)

BRUMM ET AL.

Examiner

Daniel J. Ryman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/3/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 28-37 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 29 contains the limitation "wherein the data packets used to transmit the second signaling information are transmitted in a part of the signaling packets which does not contain any first signaling information." However, in the specification, Applicant discloses that "signaling information which cannot be converted into H.323/H.450 signaling information is transmitted to the terminal 32 via the IP network 30 as DSS1 signaling information in a separate data area of the H.323/H.450 signaling packet" (pg. 14, lines 9-12). In the specification, the signaling information is not first converted into a data packet and then inserted into a part of the signaling packets, as is disclosed in claim 29. Due to this discrepancy between the claims and the specification, one of ordinary skill in the art would not have been enabled to make and/or use the invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 28, 30-32, 36, and 37 are rejected under 35 U.S.C. 102(a) as being unpatentable over Su et al. (USPN 6,693,898) in view of Applicant's admitted prior art.

6. Regarding claims 28 and 37, Su discloses a terminal device (ref. 10) coupled to a packet-switched communication network (ref. 35) (col. 4, lines 2-4). Sun further discloses a first device (ref. 40: SSP) comprising: a data processing device having a first program module, wherein said processing device configures first signaling information according to a first packet-switched standard protocol (H.323) (col. 3, lines 2-17 and col. 3, lines 50-64), and configures second signaling information according to a circuit-switched standard protocol (GR1129) (col. 3, lines 2-17 and col. 3, lines 50-64); an interface unit for operatively coupling the first device to the packet-switched network wherein the first signaling information is transmitted through the interface with the assistance of signaling packets of the packet-switched communication network, and the second signaling information is transmitted through the interface with the assistance of data packets of the packet-switched communication network (col. 3, lines 2-17 and col. 3, lines 45-64).

Sun does not expressly disclose that the terminal device contains the data processing device and the interface unit. However, Sun does disclose embedding signaling for a circuit-switched protocol in a packet in order to permit implementation of the circuit-switch commands

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in the packet network (col. 3, lines 2-17 and col. 3, lines 45-64). Applicant teaches that there are signaling commands involving terminals in circuit-switching networks that are not supported by H.323 (Specification: page 1, line18-page 4, line 14, esp. page 3-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the terminal device contain a data processing device and an interface unit in order to permit the terminal device to use signaling from a circuit-based protocol in a packet switched network.

7. Regarding claim 30, Su in view of Applicant discloses that signaling information for at least one service and/or performance feature is transmitted as second signaling information (Su: col. 1, lines 15-21 and col. 3, lines 2-17 and Applicant: page 1, line18-page 4, line 14).

8. Regarding claim 31, Su in view of Applicant discloses that the service feature and/or performance feature includes at least one of call pick up, three way conferencing, large scale conferencing, holding, displaying of toll information, a closed user group, call number identification, automatic call back when busy, automatic call back when no response, call barring, call waiting indication and call transfer (Su: col. 1, lines 15-21 and Applicant: page 1, line18-page 4, line 14).

9. Regarding claim 32, Su in view of Applicant discloses that the second signaling information, with the assistance of the packet-switched communication network, is transmitted from the terminal device to the interface unit between the packet-switched communication network and the circuit-switched communication network (Su: col. 4, lines 2-10 and col. 4, lines 29-52 and Applicant: page 1, line18-page 4, line 14).

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10. Regarding claim 36, Su in view of Applicant discloses that the terminal device is configured as a computer system with software and hardware (Su: col. 2, lines 41-46 and col. 4, lines 2-4 and Applicant: page 1, line 18-page 4, line 14).

11. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su et al. (USPN 6,693,898) in view of Applicant's admitted prior art in further view of Giordano, III et al. (USPN 6,285,364).

12. Regarding claim 33, Su in view of Applicant does not expressly disclose that the data processing system further comprises a second program module that converts the transmitted signaling information into image information to be displayed on a display unit and processes information which is input using an input unit, using data exchanged between the first program module and the second program module. Giordano teaches, in an internet phone system, having a graphical user interface which permits signaling information (e.g. caller ID) to be displayed on a display unit and which processes information input using an input unit in order to permit a user to interact with the various features available on the phone (col. 2, line 28-col. 3, line 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the data processing system further comprise a second program module that converts the transmitted signaling information into image information to be displayed on a display unit and processes information which is input using an input unit, using data exchanged between the first program module and the second program module in order to permit a user to interact with the various features available on the terminal.

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13. Regarding claim 34, Su in view of Applicant in further view of Giordano discloses that the second program module provides a graphical interface (Giordano: col. 2, line 28-col. 3, line 10).

14. Regarding claim 35, Su in view of Applicant in further view of Giordano discloses that a number of possible graphical interfaces are stored in the data processing device, and the user interfaces are optionally switched over by the second program module (Giordano: col. 2, line 28-col. 3, line 10).

### *Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Ryman whose telephone number is (571)272-3152. The examiner can normally be reached on Mon.-Fri. 7:00-4:30 with every other Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel J. Ryman  
Examiner  
Art Unit 2665

*DJR*



HUY D. VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600